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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,225	01/16/2001	Jonathan H. Bari	051726-0002	9941

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MORGAN, LEWIS & BOCKIUS LLP  
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Washington, DC 20036

EXAMINER

REVAK, CHRISTOPHER A

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/759,225	<b>Applicant(s)</b> BARI ET AL.	
	<b>Examiner</b> Christopher A. Revak	<b>Art Unit</b> 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/2/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. The Declaration filed on June 20, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Novell's Digitalme reference.
2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Novell's Digitalme reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The applicant's application relies on showing conception of the invention by reciting of a meeting with a graphic artist to discuss the design of the web site that encompassed the applicant's conception of the invention. It is recited that there was conducted a number of subsequent discussions during which the applicant instructed the graphic artist on the design of particular screen shots and graphical user interfaces where the discussions were carried out through means including emails, faxes, and meeting in person and by conversation on the telephone. The examiner notes that none of this information is presented by the applicant and the only information provided by the applicant is a registered web site containing the web site and business name of PinVault.com. This information submitted by the applicant is insufficient and various types of information that is acceptable as facts and documentary

evidence is sketches, blue prints, photographs, reproduction of notebook entries, accompanying models, attached supporting statements by witnesses, testimony given in an interference, or disclosure components may be used as documentary evidence of conception, please refer to MPEP 715.07 [R-2].

3. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Novell's Digitalme reference to either a constructive reduction to practice or an actual reduction to practice. Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence. Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947). Form paragraph 7.62 (reproduced in MPEP § 715) may be used to respond to a 37 CFR 1.131 affidavit where diligence is lacking, please refer to MPEP 715.07(a). The applicant has failed to show a detailed timeline of events beginning on April 14, 1999 up to and including January 14, 2000 which is the filing date of the provisional application.

***Non-Compliant Amendment under 37 CFR 1.121***

4. The applicant has not filed a complete listing of the claims on a separate sheet.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-43 are rejected under 35 U.S.C. 102(a) as being anticipated by Novell's Digitalme, herein after Novell, publication dated October 5, 1999.

As per claim 1, Novell teaches registering the user with a secure system; creating a personal homepage and personal database for the user by the system; inputting the user's authentication credentials for a plurality of third parties into the personal database; linking to one of the plurality of third parties by the user; retrieving and securely transmitting appropriate authentication credentials for the one of the plurality of third parties by the system: and logging the user onto the one of the plurality of third party sites (see "How digitalme works").

As per claim 14, Novell teaches registering a third party merchant as a participating merchant with the system; creating a personal homepage and personal database for the user by the system; inputting the user's authentication credentials for a plurality of third parties, including at least one participating merchant, into the personal

database; linking to the at least one participating merchant by the user; retrieving and securely transmitting appropriate authentication credentials for the at least one participating merchant by the system; logging the user onto the at least one participating merchant; purchasing a product by the user from the at least one participating merchant; and receiving, by the system, compensation from the participating merchant (see "How digitalme works" and "digitalme in the real world").

As per claims 28, 32, 36, and 40, Novell teaches the step of going to a third party site by the user further comprises the steps of: going, by the user, from the third party site to at least one second third party site; initiating an authentication process; retrieving from the system and/or the third party site and securely transmitting by the system and/or the third party site appropriate user authentication credentials for the at least one second third party Web site; and logging the user into the at least one second third party site (see "Single-click sign-on").

As per claims 2 and 15, Novell teaches the step of registering comprises inputting master authentication credentials into the system by the user (see "How digitalme works").

As per claims 3 and 16, Novell teaches the master credentials include a unique user name and a unique password (see "NDS and digitalme").

As per claims 4 and 17, Novell teaches the step of inputting authentication credentials for a plurality of third parties is performed by the user (see "How digitalme works").

As per claims 5 and 18, Novell teaches the step of inputting authentication credentials for a plurality of third parties is performed by the system (see "How digitalme works").

As per claims 6 and 19, Novell teaches the personal homepage contains authenticated links to the plurality of third parties (see "Single-click sign-on").

As per claims 7 and 20, Novell teaches wherein the step of linking comprises the step of clicking on a link to one of the plurality of third parties resident on the personal homepage (see "Single-click sign-on").

As per claims 8 and 21, Novell teaches the step of linking comprises: going to a third party Web site by the user; clicking, by the user, on an icon representing the system; inputting authentication credentials for the third party into the personal database by the user; and linking to the third party Web site by the system (see "Singleclick sign-on").

As per claims 9 and 22, Novell teaches the step of linking comprises the step of clicking on a third party icon on the personal homepage (see "Single-click sign-on").

As per claims 10 and 23, Novell teaches the step of linking comprises the steps of: inputting, by the user, information about a third party Web site into system; requesting, by the user, the system to search for the third party Web site; and finding, by the system, the third party Web site and presenting a link to the third party Web site to the user (see "Single-click sign-on").

As per claims 11 and 24, Novell teaches the step of retrieving and securely transmitting comprises the steps of: opening a new browser window by the system;

transporting user authentication credentials to the third party Web site by the system; and inputting the authentication credentials to the third party Web site (see "Single-click sign-on").

As per claims 12, 29, 33, 37, and 41, Novell teaches the system encrypts the user authentication credentials (see "How digitalme works").

As per claims 13, 30, 34, 38, and 42, Novell teaches the personal database contains personal data that is not authentication credentials (see "It all starts with a meCard").

As per claim 25, Novell teaches the step of purchasing a product includes obtaining proprietary information from the third party Web site (see "How digitalme works").

As per claim 26, Novell teaches compensation is a percentage of a price of the product purchased (see "How digitalme works").

As per claim 27, Novell teaches compensation is based upon the online visit, and/or products purchased, and/or services purchased (see "How digitalme works").

As per claims 31, 35, 39, and 43, Novell teaches the user accesses the system and/or the third party sites using a device capable of accessing the network (see "How digitalme works").



***Conclusion***


7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Friday, 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CR  
  
November 15, 2005

Christopher Revak  
Primary Examiner  
AU 2131

  
11/15/05